

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86401937
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION	
MARK	<a href="http://tmng-al.uspto.gov/resting2/api/img/86401937/large">http://tmng-al.uspto.gov/resting2/api/img/86401937/large</a>
LITERAL ELEMENT	EPIQ
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	

In response to the Trademark Attorney's Final Office Action dated December 26, 2015, the following amendments and remarks are respectfully submitted in connection with the above-identified application.

### IN THE APPLICATION

Please amend the identification of goods as follows:

--Tobacco, whether manufactured or unmanufactured; smoking tobacco, pipe tobacco, hand rolling tobacco, chewing tobacco, snus tobacco; cigarettes, electronic cigarettes, liquid for electronic cigarettes, cigars, cigarillos; snuff; smokers' articles included in Class 34, namely, cigarette papers, cigarette tubes; matches, metal pocket-sized receptacles with lids for cigarette butts; filter tubes; keystones for pipes; outdoor cigar and cigarette disposal units; outdoor receptacles for cigar and cigarette ash and waste; cigar glue; cigar relighting liquid solution; cigar storage tubes; containment clips used to keep a cigar from falling apart; ~~rehydration tubes~~; hookah charcoal, in International Class 34.--

### REMARKS

Applicant thanks the Trademark Attorney for the very thorough consideration given the present application.

### IDENTIFICATION OF GOODS

The Trademark Examining Attorney has continued to refuse registration of the present application based on U.S. Registrations 1,029,542 and 4,168,742. Based on the arguments set forth in an Amendment dated July 9, 2015, Applicant respectfully requests the Examining Attorney to reconsider the refusal to register the present application by deleting "matches, metal pocket-sized receptacles with lids for cigarette butts; filter tubes; keystones for pipes; outdoor cigar and cigarette disposal units; outdoor receptacles for cigar and cigarette ash and; cigar relighting liquid solution; cigar storage tubes; containment clips used to keep a cigar from falling apart; rehydration tubes" from the identification of goods in the present application in order to avoid the conflicts with the cited registered marks. Entry of the amended identification of goods into the official record is respectfully requested. Applicant believes that by deleting the conflicting goods, the

Examining Attorney should withdraw the Final refusal.

#### GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	034
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#### DESCRIPTION

Tobacco, whether manufactured or unmanufactured; smoking tobacco, pipe tobacco, hand rolling tobacco, chewing tobacco, snus tobacco; cigarettes, electronic cigarettes, liquid for electronic cigarettes, cigars, cigarillos; snuff; smokers' articles included in Class 34, namely, cigarette papers, cigarette tubes; matches, metal pocket-sized receptacles with lids for cigarette butts; filter tubes; keystones for pipes; outdoor cigar and cigarette disposal units; outdoor receptacles for cigar and cigarette ash and waste; cigar glue; cigar relighting liquid solution; cigar storage tubes; containment clips used to keep a cigar from falling apart; rehydration tubes; hookah charcoal

FILING BASIS	Section 44(d)
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FOREIGN APPLICATION NUMBER	53374/2014
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FOREIGN APPLICATION COUNTRY	Switzerland
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FOREIGN FILING DATE	03/20/2014
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FILING BASIS	Section 44(e)
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FOREIGN REGISTRATION NUMBER	656889
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FOREIGN REGISTRATION COUNTRY	Switzerland
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FOREIGN REGISTRATION DATE	04/02/2014
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FOREIGN EXPIRATION DATE	03/20/2024
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#### GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	034
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#### TRACKED TEXT DESCRIPTION

Tobacco, whether manufactured or unmanufactured; smoking tobacco, pipe tobacco, hand rolling tobacco, chewing tobacco, snus tobacco; cigarettes, electronic cigarettes, liquid for electronic cigarettes, cigars, cigarillos; snuff; smokers' articles included in Class 34, namely, cigarette papers, cigarette tubes; ~~matches, metal pocket-sized receptacles with lids for cigarette butts~~; hookah charcoal; ~~filter tubes~~; ~~keystones for pipes~~; ~~outdoor cigar and cigarette disposal units~~; ~~outdoor receptacles for cigar and cigarette ash and waste~~; ~~cigar glue~~; ~~cigar relighting liquid solution~~; ~~cigar storage tubes~~; ~~containment clips used to keep a cigar from falling apart~~; ~~rehydration tubes~~

#### FINAL DESCRIPTION

Tobacco, whether manufactured or unmanufactured; smoking tobacco, pipe tobacco, hand rolling tobacco, chewing tobacco, snus tobacco; cigarettes, electronic cigarettes, liquid for electronic cigarettes, cigars, cigarillos; snuff; smokers' articles included in Class 34, namely, cigarette papers, cigarette tubes; hookah charcoal

FILING BASIS	Section 44(d)
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FOREIGN APPLICATION NUMBER	53374/2014
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FOREIGN APPLICATION COUNTRY	Switzerland
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FOREIGN FILING DATE	03/20/2014
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INTENT TO PERFECT 44(d)	At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.
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FILING BASIS	Section 44(e)
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FOREIGN REGISTRATION NUMBER	656889
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FOREIGN REGISTRATION COUNTRY	Switzerland
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FOREIGN REGISTRATION DATE	04/02/2014
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FOREIGN EXPIRATION DATE	03/20/2024
<b>ADDITIONAL STATEMENTS SECTION</b>	
MISCELLANEOUS STATEMENT	CONCLUSION It is believed that the present application should be in condition for publication. An early Notice of Publication is respectfully requested. Please charge any fees or credit any overpayment pursuant to 37 C.F.R. § 2.6 to Deposit Account No. 02-2448.
<b>SIGNATURE SECTION</b>	
RESPONSE SIGNATURE	/James M. Slattery/
SIGNATORY'S NAME	James M. Slattery
SIGNATORY'S POSITION	Attorney of Record, VA Bar Member
SIGNATORY'S PHONE NUMBER	(703) 205-8000
DATE SIGNED	06/24/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Fri Jun 24 14:01:35 EDT 2016
TEAS STAMP	USPTO/RFR-XXX.XX.XXX.XXX- 20160624140135004397-8640 1937-550c08e30f87a5ec8175 e72b11f2164a94758b10f74a8 a50d81973ea7af53dc-N/A-N/ A-20160624110114291216

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PTO Form 1960 (Rev 10/2011)  
OMB No. 0651-0050 (Exp 07/31/2017)

### Request for Reconsideration after Final Action

#### To the Commissioner for Trademarks:

Application serial no. **86401937** EPIQ(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86401937/large>) has been amended as follows:

#### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

In response to the Trademark Attorney's Final Office Action dated December 26, 2015, the following amendments and remarks are respectfully submitted in connection with the above-identified application.

#### IN THE APPLICATION

Please amend the identification of goods as follows:

--Tobacco, whether manufactured or unmanufactured; smoking tobacco, pipe tobacco, hand rolling tobacco, chewing tobacco,

snus tobacco; cigarettes, electronic cigarettes, liquid for electronic cigarettes, cigars, cigarillos; snuff; smokers' articles included in Class 34, namely, cigarette papers, cigarette tubes; matches, metal pocket-sized receptacles with lids for cigarette butts; filter tubes; keystones for pipes; outdoor cigar and cigarette disposal units; outdoor receptacles for cigar and cigarette ash and waste; cigar glue; cigar relighting liquid solution; cigar storage tubes; containment clips used to keep a cigar from falling apart; ~~rehydration tubes~~; hookah charcoal, in International Class 34.--

### REMARKS

Applicant thanks the Trademark Attorney for the very thorough consideration given the present application.

### IDENTIFICATION OF GOODS

The Trademark Examining Attorney has continued to refuse registration of the present application based on U.S. Registrations 1,029,542 and 4,168,742. Based on the arguments set forth in an Amendment dated July 9, 2015, Applicant respectfully requests the Examining Attorney to reconsider the refusal to register the present application by deleting "matches, metal pocket-sized receptacles with lids for cigarette butts; filter tubes; keystones for pipes; outdoor cigar and cigarette disposal units; outdoor receptacles for cigar and cigarette ash and; cigar relighting liquid solution; cigar storage tubes; containment clips used to keep a cigar from falling apart; rehydration tubes" from the identification of goods in the present application in order to avoid the conflicts with the cited registered marks. Entry of the amended identification of goods into the official record is respectfully requested. Applicant believes that by deleting the conflicting goods, the Examining Attorney should withdraw the Final refusal.

### CLASSIFICATION AND LISTING OF GOODS/SERVICES

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 034 for Tobacco, whether manufactured or unmanufactured; smoking tobacco, pipe tobacco, hand rolling tobacco, chewing tobacco, snus tobacco; cigarettes, electronic cigarettes, liquid for electronic cigarettes, cigars, cigarillos; snuff; smokers' articles included in Class 34, namely, cigarette papers, cigarette tubes; matches, metal pocket-sized receptacles with lids for cigarette butts; filter tubes; keystones for pipes; outdoor cigar and cigarette disposal units; outdoor receptacles for cigar and cigarette ash and waste; cigar glue; cigar relighting liquid solution; cigar storage tubes; containment clips used to keep a cigar from falling apart; rehydration tubes; hookah charcoal  
Original Filing Basis:

**Filing Basis: Section 44(d), Priority based on foreign filing: *For a trademark or service mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services, and asserts a claim of priority based upon a foreign application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization, and asserts a claim of priority based upon a foreign application. ***For a certification application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant, and the applicant asserts a claim of priority based upon a foreign application. Claim of priority is based on [ Switzerland application number 53374/2014 filed 03/20/2014]. 15 U.S.C. Section 1126(d), as amended.

**Filing Basis: Section 44(e), Based on Foreign Registration: *For all applications:*** The applicant attaches a copy of [ Switzerland registration number 656889 registered 04/02/2014 with a renewal date of \_\_\_\_\_ and an expiration date of 03/20/2024 ], and translation thereof, if appropriate. ***For a trademark or service mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users on or in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant.

### **Proposed:**

**Tracked Text Description:** Tobacco, whether manufactured or unmanufactured; smoking tobacco, pipe tobacco, hand rolling tobacco, chewing tobacco, snus tobacco; cigarettes, electronic cigarettes, liquid for electronic cigarettes, cigars, cigarillos; snuff; smokers' articles included in Class 34, namely, cigarette papers, cigarette tubes; ~~matches, metal pocket-sized receptacles with lids for cigarette butts~~; hookah charcoal; ~~filter tubes~~; ~~keystones for pipes~~; ~~outdoor cigar and cigarette disposal units~~; ~~outdoor receptacles for cigar and cigarette ash and waste~~; ~~cigar glue~~; ~~cigar~~

~~relighting liquid solution; cigar storage tubes; containment clips used to keep a cigar from falling apart; rehydration tubes~~

Class 034 for Tobacco, whether manufactured or unmanufactured; smoking tobacco, pipe tobacco, hand rolling tobacco, chewing tobacco, snus tobacco; cigarettes, electronic cigarettes, liquid for electronic cigarettes, cigars, cigarillos; snuff; smokers' articles included in Class 34, namely, cigarette papers, cigarette tubes; hookah charcoal

**Filing Basis: Section 44(d), Priority based on foreign filing:***For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services, and asserts a claim of priority based upon a foreign application. *For a collective trademark, collective service mark, or collective membership mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization, and asserts a claim of priority based upon a foreign application. *For a certification mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant, and the applicant asserts a claim of priority based upon a foreign application. Claim of priority is based on [ Switzerland application number 53374/2014 filed 03/20/2014]. 15 U.S.C. Section 1126(d), as amended.

**INTENT TO PERFECT 44(d) :** At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.

**Filing Basis: Section 44(e), Based on Foreign Registration:***For all applications:* The applicant attaches a copy of [ Switzerland registration number 656889 registered 04/02/2014 with a renewal date of \_\_\_\_\_ and an expiration date of 03/20/2024 ], and translation thereof, if appropriate, before the application may proceed to registration. *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services. *For a collective trademark, collective service mark, or collective membership mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. *For a certification mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users on or in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant.

## ADDITIONAL STATEMENTS

### Miscellaneous Statement

**CONCLUSION** It is believed that the present application should be in condition for publication. An early Notice of Publication is respectfully requested. Please charge any fees or credit any overpayment pursuant to 37 C.F.R. § 2.6 to Deposit Account No. 02-2448.

## SIGNATURE(S)

### Request for Reconsideration Signature

Signature: /James M. Slattery/ Date: 06/24/2016

Signatory's Name: James M. Slattery

Signatory's Position: Attorney of Record, VA Bar Member

Signatory's Phone Number: (703) 205-8000

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86401937

Internet Transmission Date: Fri Jun 24 14:01:35 EDT 2016

TEAS Stamp: USPTO/RFR-XXX.XX.XXX.XXX-201606241401350

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/A-N/A-20160624110114291216